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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,870	10/26/2001	Holger Warth	Mo-6717/LeA 34,668	1030
157	7590	10/05/2004	EXAMINER	
BAYER MATERIAL SCIENCE LLC 100 BAYER ROAD PITTSBURGH, PA 15205			BUTTNER, DAVID J	
			ART UNIT	PAPER NUMBER
			1712	
DATE MAILED: 10/05/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,870

Applicant(s)

WARTH ET AL.

Examiner

David Buttner

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 limits the group of vinyl cyanides, methacrylic esters, unsaturated acids and derivatives of the acid to being present in amount of 1-50 parts of polymer B. However, methacrylic esters were earlier listed as being possibly present in amount of 50-99 parts. The two amounts are inconsistent, which is intended?

Claims 1-5 and 7-9 are rejected under 35 USC as obvious over Nodera '443.

Nodera exemplifies (Nos. 5, 6,) blends of PC, HIPS, Metablen S2001, talc, antistatic agent and flame retardants. Metablen S2001 is one of applicant's preferred silicone-acrylate grafts (page 15, line 24 of spec.) HIPS is a polymer based on styrene and qualifies as applicant's (B). Nodera (col 4 line 63) also lists acrylonitrile/styrene copolymer as an alternative to HIPS. Glass fibers (col. 10, line 45) are listed as an alternative to talc.

"Consisting of" excludes the presence of flame retardants and antistatic agents from applicant's claims. It would have been obvious to eliminate these additives as well as their functions if flame retardancy and electrical resistivity were not of concern(MPEP 2144.04 II).

Claims 1-5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the J11349796 Patent in view of Nodera '443 or Obayashi '914.

The JP11349796 reference exemplifies blends of PC, SAN and silicon/acrylate graft. Oral translation indicates paragraph 19 calls for inorganic filler (termed "bulking agent" by the machine translation), but glass fibers are not named.

Nodera (col. 10, line 44,45,63) lists glass fiber etc in amounts of 2-30 pph as suitable filler in similar PC/grafted rubber compositions. Obayashi exemplifies the use of glass fiber in similar PC/ grafted rubber compositions. It would have been obvious to use glass fibers as the filler in the J'796 compositions in the conventional amounts for the expected reinforcing effect.

Takahashi 2003/0112520 (paragraph 102) is cited for his more detailed description of the SAN 290FF that is believed used in J'796.

Claims 1-5 and 7-9 rejected under 35 U.S.C. 103(a) as being unpatentable over the JP08269314 Patent in view of Nodera '443 or Obayashi '914.

The JP08269314 reference exemplifies blends of PC, PMMA and Metablen S2001 (applicant's silicone graft). Reinforcing materials such as fibers can be included (paragraph 56) although glass fibers and amounts thereof amounts are not specified.

Nodera (col. 10, line 44,45,63) lists glass fiber etc in amounts of 2-30 pph as suitable filler in similar PC/grafted rubber compositions. Obayashi exemplifies the use of glass fiber in similar PC/ grafted rubber compositions.

It would have been obvious to use glass fibers as the reinforcing fiber in the J '314 composition in the conventional amounts for the expected reinforcing effect.

Applicant's arguments filed 7/30/04 have been fully considered but they are not persuasive.

Applicant does not agree claim 4 is indefinite.

The following hypothetical situation illustrates the confusion. A hypothetical copolymer such as a 75/25 methylmethacrylate/butylmethacrylate would not meet the claim. Is this intended? Applicant has limited the copolymer to having 1-50 parts of vinylcyanides, methacrylic esters, unsaturated carboxylic acids and derivatives of carboxylic acids. The proposed hypothetical copolymer has 100% methacrylic esters because both monomers qualify as methacrylic esters. "100" violates the "1-50" limitation. Perhaps applicant intends to ignore the methylmethacrylate when calculating the amount of B.2 monomers present. This would be improper because all the monomers qualifying as B.2 monomers must sum to 1-50. One cannot arbitrarily ignore some methacrylic esters when calculating the amount of B.2. A potential infringer could just as easily consider the methylmethacrylate as B.2 and the butylmethacrylate as B.1. This would fall outside the scope of the claim because "75% methylmethacrylate" does not meet "1-50" and "25% butylmethacrylate" does not meet the "50-99" limitation.

Applicant argues Nodera requires the presence of ingredients that are now excluded from the claims.

This is true, but applicant has not addressed the obviousness of removing an element as well as its function. It appears applicant is taking an obvious step backward in the art by removing elements from a known/obvious composition that are unnecessary for applicant's purposes.

Applicant does not make any clear argument why it would not be obvious to use a well known reinforcing material such as glass fiber in the blends of the Japanese references. The primary references call for reinforcers and/or fillers in general.

.THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 1712

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAVID J. BUTTNER
PRIMARY EXAMINER

D. Buttner
September 30, 2004

A handwritten signature in black ink that reads "David Buttner". The signature is written in a cursive, flowing style.